



Docket No.: SON-2024
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Motoshi ASANO et al.

Application No.: 09/774,682

Confirmation No.: 3648

Filed: February 1, 2001

Art Unit: 3696

For: ELECTRONIC-MONEY SETTLEMENT
METHOD AND INFORMATION
PROCESSING APPARATUS THEREFOR

Examiner: F. Poinvil

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This is a Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on February 9, 2009.

All arguments presented within the Appeal Brief of November 13, 2008 are incorporated herein by reference. Additional arguments are provided hereinbelow.

Claims 1, 3-4 and 9-38 are currently pending in this application. No claims have been allowed.

Among others, the following positions were presented in the Examiner's Answer, each of which will be addressed in turn in this Reply Brief:

ARGUMENT

Examiner erred in rejecting claims 1, 3, 4, 9-38 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka) in view of Japanese Application Publication number 62-264364 (Kamimura) and/or Japanese Application Publication number 11-161832 (Purse Japan:KK) and U.S. Patent No. 5,679,938 (Templeton).

Nonaka - The Appeal Brief on page 8 highlights that Nonaka **fails** to disclose, teach or suggest an **absence** of an ID number from the storage 60 as identifying an ID card 1 as an enabled device.

In response, the Examiner's Answer **admits** on page 12 that in regard to the ID number, it is noted that Nonaka **does not provide this obvious detail.**

Instead, the Examiner's Answer asserts on page 12, without providing any objective teaching that:

- It would have been apparent to one of ordinary skill in the art at the time of the invention that each borrower associated with an electronic purse must have a unique identification so that for easy data storage and retrieval in/from the data center and also to differentiate one borrower from another borrower.
- If a borrower fails to make timely payment, that borrower's loan status associated with his/her identification would have been in a negative list, thus rendering the device inoperative or disabled.
- If a borrower continues to make timely payments, his/her status would be in a positive list, rendering the device to be enabled.
- If the user's status is negative or if the user does not make timely payment or if the status is delinquent, the user will not be able to use the card because the lender or card issuer would render the card inoperative or the card issuer would disable the card.

However, the Examiner's Answer fails to highlight a disclosure within Nonaka where any of these assertions could be readily found.

As noted in the Appeal Brief on page 8, Nonaka merely determines whether or not the ID number is "cataloged" (Nonaka at Figure 3, steps S106 and S121; Figure 4, steps S206 and S221; Figure 6, steps S308; Figure 8, steps S406 and S420; Figure 11, steps S506).

- *Thus, Nonaka fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.*

The Appeal Brief on page 9 highlights that Nonaka fails to disclose, teach or suggest information on a loan is recorded in both the IC Card 1 and the center 3 of Nonaka.

In this regard, none of the Figures 3, 4, 6, 8, 11, and 12 of Nonaka appear to teach or suggest information on a loan is recorded in the IC Card 1 and the center 3 of Nonaka.

Additionally, the Examiner's Answer admits on page 5 that Nonaka fails to teach or suggest information on a loan is recorded in the IC card.

Nevertheless, the Examiner's Answer asserts that pages 12-13 of Nonaka teaches several conditions for recording information in the electronic purse and in the management center (Examiner's Answer at page 13).

- *Thus, Nonaka fails to disclose, teach or suggest the step of recording, in said enabled device and said management center, information on a loan made to the user of said*

enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device.

The Examiner's Answer on page 4 contends that Figure 2a and 2b and 5 and 10 of Nonaka show the format of the data storage in the electronic purse 2.

Figure 2a and 2b of Nonaka are provided hereinbelow.

FIG. 2(a)

ID NUMBER	CONTENTS OF LOAN	
	SUM	DATE

FIG. 2(b)

ID NUMBER	CONTENTS OF LOAN	
	SUM	DATE

Figure 5 and 10 of Nonaka are provided hereinbelow.

FIG. 5

ID NUMBER	CONTENTS OF LOAN		
	MAXIMUM SUM	SUM	DATE

FIG. 10

ID NUMBER	ENTRAINED STATION CODE	CONTENTS OF LOAN	
		SUM	DATE

Here, Figure 2a and 2b and 5 and 10 of Nonaka fail to show the format of the data storage in the electronic purse 2.

Instead, Nonaka arguably teaches the presence of the personal information storage 34 in the center 3 (Nonaka at Figure 1, page 19, line 23 to page 20, line 5).

Figures 2a and 2b and 5 and 10 of Nonaka depict reference number 34.

Also note that the electronic purse 2 of Nonaka is shown within Figure 1 to be different than the personal information storage 34.

Moreover, please note that Nonaka is silent regarding any interest calculation.

- ***Thus, Nonaka fails to disclose, teach or suggest a method wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.***

Purse Japan:KK - The Examiner's Answer refers to Purse Japan:KK for the features that are deficient from within Nonaka. Specifically, the Examiner had relied on the teachings of Purse Japan:KK to denote the storing of loan data into a portable device (Examiner's Answer at page 12).

In response, Purse Japan:KK may quite possibly disclose that according to instructions of CPU20, rotate the card feed rollers 44 and 44 clockwise, and the prepaid card 80 is sent out toward the entry 14a, and loan data is recorded on the prepaid card 80 into the distance (Purse Japan:KK at paragraph [0011]).

However, Purse Japan:KK fails to disclose, teach or suggest an absence of a identification code from a negative list identifying a portable electronic device as an enabled device.

- ***Thus, Purse Japan:KK fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list,***

a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and

an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

Furthermore, Purse Japan:KK fails to disclose an apparatus and method that includes the recording of information on a loan when a payment amount exceeds the remaining amount of the electronic money stored in the enabled device.

- *Thus, Purse Japan:KK fails to disclose, teach or suggest the step of recording, in said enabled device and said management center, information on a loan made to the user of said enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device.*

Additionally, Purse Japan:KK is silent regarding the calculation of interest on the loan.

- *Thus, Purse Japan:KK fails to disclose, teach or suggest a method wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.*

Kamimura - The Examiner's Answer refers to Kamimura for the features that are deficient from within Nonaka. Specifically, the Examiner had relied on the teachings of Kamimura to denote the storing of loan data into a portable device (Examiner's Answer at page 12).

Without the benefit of a translation of Kamimura, the Abstract of Kamimura appears to disclose that:

When a customer puts a card medium 1 into a reading means 2, the data intrinsic to the customer are read by the reading means 2. Then the loan transaction data is supplied through an operation input means 3 and a deciding means 4 decides the propriety of a transaction based on said read-out data and the loan transaction data.

If the transaction is possible, the data showing a transaction-enable state is recorded on the medium 1. Then the customer puts such a card medium 1 into the cash dispenser, etc. to receive a loan.

However, the Abstract of Kamimura fails to disclose, teach or suggest an absence of a identification code from a negative list identifying a portable electronic device as an enabled device.

- *Thus, the Abstract of Kamimura fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list,*

a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and

an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

Furthermore, the Abstract of Kamimura fails to disclose an apparatus and method that includes the recording of information on a loan when a payment amount exceeds the remaining amount of the electronic money stored in the enabled device.

- *Thus, the Abstract of Kamimura fails to disclose, teach or suggest the step of recording, in said enabled device and said management center, information on a loan made to the user of said enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device.*

Additionally, the Abstract of Kamimura is silent regarding the calculation of interest on the loan.

- *Thus, the Abstract of Kamimura fails to disclose, teach or suggest a method wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.*

Templeton - Page 12 of the Appeal Brief notes that Templeton arguably teaches that the MICR reader includes a MICR read head (not shown) positioned adjacent a MICR slot 55, and is operative for electronically reading the MICR characters 60 on a check 65 (Templeton at column 12, lines 9-13).

Templeton arguably teaches that the host computer 35 then accesses the negative file 85, which contains bad check data that has been accumulated by the check acceptance service (Templeton at column 13, lines 18-20).

However, Templeton fails to disclose, teach, or suggest the “bad check data” as including an identification code for the check 65.

The Examiner’s Answer fails to highlight any disclosure within Templeton in rebuttal to the observations found within the Appeal Brief.

Instead, the Examiner’s Answer contends on page 14, *without providing any supporting evidence*, that whether or not the combined teaching fails to show this limitation, it is well known in the art that lenders usually lend money or funds at a particular interest rate for a particular limit.

In response, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). However, this contention is merely a personal conclusion that is unsupported by any objective evidence.

As a rule, assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA

1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner’s affidavit upon request. Specifically, “when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 C.F.R. §1.104(d) (2).

Accordingly, *Applicant hereby requests a reference or an Examiner’s affidavit to support this officially noticed position of obviousness or what is well known.*

Further, note that if this reference or Examiner’s affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

Also, note that the *failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error*. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

CONCLUSION

There is no concession as to the veracity of Official Notice, if taken in any Office Action.

An affidavit or document should be provided in support of any Official Notice taken. 37 CFR 1.104(d)(2), MPEP § 2144.03. See also, *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989)(failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error).

The prior art of record fails to disclose, teach or suggest all the features of the claimed invention. For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

For at least the reasons set forth hereinabove, the rejection of the claimed invention should not be sustained. Therefore, a reversal of the rejection of April 2, 2008 is respectfully requested.

If any additional fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 5, 2009

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

Christopher M. Tobin

Registration No.: 40,290

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorneys for Applicant